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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS GRAFENAUER

Appeal 2008-4135
Application 10/697,567
Technology Center 3600

Oral Hearing Held: February 12, 2009

Before WILLIAM F. PATE, III, JOHN C. KERINS, and STEVEN D.A. McCARTHY, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

ANDREW M. CALDERON, ESQUIRE
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34 The above-entitled matter came to be heard on Thursday, February 12,
35 2009, commencing at 1:55 p.m., at the United States Patent and Trademark
36 Office, 600 Dulany Street, Alexandria, Virginia, before Laurel P. Platt,
37 Notary Public.

PROCEEDINGS

THE CLERK: Calendar number 54, Mr. Calderon.

JUDGE PATE: Good afternoon, Mr. Calderon.

MR. CALDERON: Good afternoon.

JUDGE PATE: Would you introduce who you have with you?

MR. CALDERON: Oh, yes. This is Mr. Andy Wright, an associate in our office, who will just be sitting in.

JUDGE PATE: Sure. That's perfectly fine.

We've had a chance to look at this case beforehand. I think we're up to speed on the technology, so we'd like to hear your arguments concerning stability.

MR. CALDERON: Fantastic. If I could go ahead and just get myself situated here a little bit.

JUDGE PATE: Sure.

MR. CALDERON: The first thing that I would like to do is I would
to focus your attention on seven claims today, claim number 15 and
endent claim 4, 9, 12 and 13.

Now, basically, I would like you to refer to figures number 2 and 3 in particular invention.

We have several unique features in here which allow us to have advantages over other flooring panels themselves. The first thing we have are these form-fitting elements, which are 23 and 24 designated figure number 3.

JUDGE McCARTHY: Counsel, is the term "form-fitting element" used anywhere in your Specification?

1 MR. CALDERON: It is in the figure here, and they are defined as
2 these milled step-like features.

3 JUDGE McCARTHY: Where is that in the Specification?

4 MR. CALDERON: If you'll give me a moment here. It looks like in
5 the Specification we define it as reference number 23 and 24, and we define
6 that in figure number 3 and also at line 24, page 4, through line 11 of page 5,
7 where we define what these form-fitting elements are, and that's the milled
8 step-like features or relief that we have.

9 And we further define them also in that they are spaced apart in two
10 orientations, the vertical orientation and the horizontal.

11 JUDGE McCARTHY: But there's no definition of what a form-fitting
12 element is?

13 MR. CALDERON: Other than mentioning that there is a step-like
14 milled relief and that they are form-fitting elements, there's nothing in there
15 per se other than looking at the figure, which you will notice that they are
16 protrusions that are sticking out of part of the wall itself which will engage
17 with what we call undercuts in here which allow the panel to be locked in a
18 vertical direction.

19 What we have here, we specifically mention that we have two of them
20 that are spaced apart both in the vertical and the horizontal orientation,
21 which provides you with the advantage of being able to lock in the vertical.

22 If you only had one of these form-fitting elements, which other panels
23 do have a single form-fitting element, what ends up happening is that you
24 are able to -- if I, for example, took two panels and put them together, I'd be
25 able to rotate one of the panels still in the vertical direction.

26 However, with having these two form-fitting elements or protrusions

1 that are spaced apart from one another, you are no longer able to rotate it.
2 They are locked in the vertical. So both this direction, as well as the rotation
3 in the vertical, is now not possible due to the locking mechanism that we
4 have here.

5 JUDGE McCARTHY: Counsel, in what way are the elements form-
6 fitting?

7 MR. CALDERON: They're form-fitting with the undercuts over here,
8 so they form-fit together.

9 JUDGE McCARTHY: So in order to determine what a form-fitting
10 element is, we need to know what the shape of the opposite side of the tile
11 is?

12 MR. CALDERON: No. I would say that one skilled in the art would
13 know what form-fitting elements are in the field itself.

14 They are protrusions. They are locking mechanisms themselves.

15 They are something that will lock in combination with the description
16 that we have in a vertical orientation, which, granted, there are other floor
17 panels that we know of that have a single locking element or they have two
18 locking elements, such as in figure number 5 of the Palsson reference which
19 shows two step-like features in figure number 5, which, if I recall correctly,
20 is reference number 23 and 24.

21 However, in that particular feature of figure number 5, you'll notice
22 here the form-fitting elements are not oriented in the horizontal and vertical
23 direction as we have, meaning that they're not separated in the same way.
24 They are vertically aligned with one another, whereas what we have is
25 spaced apart in both the transverse and vertical direction.

26 Due to this feature -- and actually, this happens to be --

1 JUDGE McCARTHY: Actually, Counsel, why isn't the lower cheek
2 surface 21 or its counterpart a form-fitting element?

3 MR. CALDERON: That wouldn't stop any sort of vertical movement,
4 Judge McCarthy.

5 What really does and what the Specification of Palsson specifically
6 mentions is that what 23 and 24 do, as you could imagine here, is it stops the
7 horizontal movement. It's a blocking mechanism for the horizontal aspect,
8 and it has no undercut there as well. It's simply for horizontal, not for the
9 vertical aspect, as we would have in here.

10 So if you did a side-by-side comparison of Palsson, and regardless of
11 whether you are looking at figure number 5, figure number 6 or figure
12 number 7, since they basically have the same features, is that this cheek
13 mechanism is only for stopping it in horizontal. So you'll see right over here
14 that the 21 and 22 feature is sort of a blocking mechanism for the horizontal.

15 JUDGE McCARTHY: But aren't 21 and 22 form-fitted to each other?

16 MR. CALDERON: I would say that they are resting on one another,
17 but they are not a form-fitting element in the way that we are using it in our
18 Specification, the way that we say that it's abutting against the undercuts,
19 which in ours are 240 and 230 of the panel itself.

20 JUDGE McCARTHY: So do we have to look at your Specification to
21 define the term form-fitting element?

22 MR. CALDERON: Certainly you look to the Specification to define
23 what it is, not that I'm imputing any sort of limitations into the claim itself.
24 But certainly looking at the Specification, looking at the figures, you can
25 clearly discern what we mean by form-fitting elements.

26 We specifically define it as a step milled like feature. We specifically

1 define it as being associated with the inner and the outer walls, which are
2 designated as 27 and 22 respectively, and we specifically mention that they
3 are 24 and 23 in there.

4 We then go on to specifically --

5 JUDGE McCARTHY: Are form-fitting elements for locking in the
6 vertical direction then best construed under section 112, paragraph 6, if we
7 are looking to the Specification to determine --

8 MR. CALDERON: No, I would say that they should be construed not
9 under 112, sixth paragraph. They are the structure itself.

10 Form-fitting elements, again, what one of ordinary skill in the art
11 would know of a form-fitting element would be a locking mechanism of
12 some sort.

13 The difference, again, between the Palsson reference and our specific
14 art -- and we specifically mention this both in claim 1 and claim number 5 --
15 is that we are spaced apart both in the vertical and horizontal, and it is for the
16 locking of the panel in the vertical direction.

17 So one of ordinary skill in the art looking at the Specification, looking
18 at the figures, looking at the actual structure itself, would construe this as a
19 structural limitation itself, just as a protrusion would be a structural
20 limitation.

21 In fact, what I would say to you is that they would be basically
22 equivalent to one another, a protrusion or a form-fitting element, with one of
23 skilled in the art.

24 So both of those have something to them, some structure to them.
25 They connote some structure to them. So that I would not necessarily be
26 looking to the Specification in order to interpret it under 112, the sixth

1 paragraph.

2 In view of that, that taken in combination with what we have are the
3 undercuts themselves. We look to see how these are able to interact with
4 one another.

5 The undercuts as well, since they are specifically mentioned to be
6 associated with the respective form-fitting elements, would also be on
7 different planes, that being spaced apart both in the transverse and the
8 vertical direction.

9 So with that said, you look at the figure number 5, figure number 6,
10 figure number 7 here of the Palsson.

11 At best, in figure number 5 you would have these two step-like
12 features at 24 and 25. However, those two step-like features are not spaced
13 apart both in the horizontal and the vertical. At best they're in the vertical.

14 The cheeks itself have no structure in them whatsoever or would not
15 be connoted as a structure to stop in the vertical direction.

16 JUDGE McCARTHY: Is there anything in the record we can look for
17 to determine how one skilled in the art might interpret the term form-fitting
18 element?

19 MR. CALDERON: In this record, to the best of my recollection, it
20 would be just the arguments that we have made.

21 It would also be, I would submit respectively, it would be figure
22 number 3, figure number 2 as well, which clearly show that there's a
23 protrusion or a substantially vertical wall that clearly has some sort of an
24 angle to it, which we mentioned, which would be something that would
25 cause a locking itself with the panel once it is -- in conjunction with the
26 undercuts, both of them, again, as we defined them, being step-like milled

1 reliefs.

2 So again, the step-like milled reliefs would be something that a
3 structure in itself which goes ahead and defines what these protrusions are as
4 well as defines what the undercuts are.

5 So as far as claims number 1 and 5 are concerned, our contention is
6 that the cheek itself is not a form-fitting element. There is no undercut in
7 there. And in fact, there is no possible way for figure number 5, 6 or 7 to
8 provide the same advantages that we provide.

9 In fact, looking at figure number 1 of the Palsson reference, which is
10 somewhat similar in the sense that there is no form-fitting element to the
11 right-hand side of the figure related to panel number 3, which is rotated
12 upward, this is the exact thing that could happen with the Palsson reference
13 itself in that it does not lock it in the vertical.

14 I'm able to just pick this up because there is nothing in this area.
15 There's nothing underneath the panel itself that would prevent that single
16 panel from lifting up.

17 JUDGE KERINS: Counsel, going back to figure 5 of Palsson, the
18 joint is not fully made up in the illustration.

19 Once that joint is fully made up, if you attempt to move the panel to
20 the right in a rotational manner, if we have a point about which the rotation
21 takes place, wouldn't the tooth that surface 21 engages surface 22, wouldn't
22 that have a -- require a horizontal component of movement, that surface 22
23 would stop?

24 MR. CALDERON: If I understand you correctly, it absolutely stops it
25 in the horizontal. The Palsson reference specifically mentions that 21 and 22
26 stop it in the horizontal. But you'll also notice that in this particular case,

1 which I'm going to call this being the groove on panel number 3, which is
2 your left side --

3 JUDGE KERINS: If we could go to figure 5.

4 MR. CALDERON: Oh, excuse me, figure number 5 on the Palsson
5 reference.

6 You will see that -- and this is very typical of many of these panels --
7 that the grooved portion, which is right over here related to the cheek -- if
8 you go to 21, 22, you go down a little bit -- it's a very thin, thin piece over
9 there. What that does is it's elastic. It allows this elasticity.

10 That in combination with the slope of this being not at 90 degrees but
11 being probably somewhere at a 60 to 45 degree angle, will allow a rotation.
12 Just as you have the rotation here in figure number 1 which allows you to
13 put it together, it will allow it to take it apart.

14 Now, another novel thing that we have in our particular invention is
15 not only do we have this locking in the vertical -- you might say, well, how
16 do I lock it in the vertical if I have this particular form-fitting element that's
17 on the right-hand side of the panel?

18 Well, that has also to do with claim number 5, as well as claim
19 number 4, where we specifically mention that we have a horizontal head
20 surface with a channel.

21 If you refer to our figure number 2, for example, you will see that we
22 have a channel, which is 26 prime. 26 prime is in surface 26. In figure 4 in
23 particular -- excuse me -- in claim number 4 in particular, we define what
24 that channel is. That channel is formed from, again, the step-like milled
25 relief, which is structure.

26 We then go on to say that that relief has an outer wall and another

1 outer wall, which in our particular figure, again, referring to figure 3, would
2 be outer wall 22 and wall 27. That forms a shoulder. The shoulder extends
3 from underneath the panel. And then the head surface is in the shoulder, and
4 then the channel is in the head surface itself.

5 So we certainly show the lineage in the structure of having a milled
6 step-like relief, which has outer walls, forms a shoulder. The shoulder has a
7 horizontal surface. The horizontal surface has the head surface. The head
8 surface has the channel.

9 Now, you will notice in figure number 5, as well as all of the other
10 figures that the Examiner refers to, 6 and 7, don't have that particular
11 structure.

12 But before I get to that, again, let me just emphasize the advantage of
13 having this particular channel is that it allows elasticity of the tongue itself.

14 So it gives you a spring-like action to it, so that I am now able to, with
15 these form-fitting elements that are both horizontally and vertically spaced
16 apart from one another, in order to allow them to snap in together.

17 Now, the channel in and of itself is not a trivial task to manufacture.
18 You'll have to understand that, of course, none of these figures are drawn to
19 scale.

20 But these panels are maybe, maybe 10 millimeters in thickness. The
21 tongue portion, which would be the shoulder -- from the bottom of the
22 shoulder of the head portion to the top surface may be about 5 millimeters.
23 So we are talking very small distances here.

24 Now, in order for me to get the channel in the head surface, you could
25 imagine that if I milled too much into it, what would happen during the
26 manufacturing process is it would crack. It would break off. These are

1 MBH, HDF pieces of wood. They're pressed wood of some sort.

2 In turn, if I am able to, and it doesn't crack during that particular
3 manufacturing process, you could imagine that if I made the channel too
4 deep, then during the installation it would crack because I am putting certain
5 stresses on it.

6 But to the contrary of that, if I didn't make it deep enough, I wouldn't
7 get that weakness that I need which gives me the spring-like feature to that.

8 So with that said, the combination of the head surface having that
9 channel and these two locking mechanisms make this particularly work,
10 make this work, the panel work such that I am able to rotate it, lock it down,
11 keep it locked in the vertical orientation.

12 Now, getting to the Palsson reference, you'll notice here in Palsson
13 that what he refers to, that being the Examiner with all due respect, refers to
14 as this channel is the space between this panel which is designated as 5, it
15 looks like, and to the right of reference number 21 and 22.

16 But that itself is not the same thing. That is not in a horizontal surface
17 of a shoulder. It certainly doesn't meet the limitations of claim number 4.

18 Because if you refer to our brief itself, we do have a particular side-
19 by-side comparison, which I did bring here, in that looking at our particular
20 feature, we have here to the right in figure -- excuse me -- to the left, figure
21 number 2 of ours, we clearly show that the channel is formed in a horizontal
22 surface of that shoulder itself.

23 So even taking claim number 5, which has the more general recitation
24 of the channel, it's still in a horizontal surface.

25 Claim number 4, which is even more specific, specifically mentions
26 shoulder, which is defined by the step milled feature, which is defined by the

1 outer wall, which is then a horizontal surface in the shoulder which then has
2 the channel.

3 That would be equivalent to basically their tongue right over here.
4 And the tongue, as we can see, is something that is flat. There is no channel
5 in here. In fact, there's no need to have a channel in there because they don't
6 have the two locking mechanisms that we have.

7 They're able to do a clear rotation down, and it will lock in the
8 horizontal due to 21 and 22 surfaces or in the vertical due to the 23 and 24,
9 but you're still able to rotate. There's not going to be any of that clicking
10 mechanism and that additional lock that we have for the vertical orientation.

11 Now, why did I mention to you the difficulty in manufacturing such a
12 channel? Well, I don't think, in my opinion, that they would even take the
13 chance of wanting to put a channel in a structure like this because again the
14 tolerances, the dimensions that we are talking about, are so tight that there is
15 the possibility of this breaking.

16 Why would they ever want that to happen when they don't particularly
17 need that to happen?

18 So as far as claim number 5 is concerned, not only do we have the
19 spaced-apart form-fitting elements in the vertical and horizontal, we
20 specifically have the head surface that has the channel.

21 Claim number 4, we even further define what that head surface and
22 channel is as the shoulder which has the outer walls which are bound there
23 with the horizontal surface which has the channel in there.

24 In addition, in claim number 4 we specifically mention the undercut.
25 The undercuts we specifically mention again are milled like reliefs.

26 We specifically mention that they correspond to the particular

1 form-fitting elements. So by its nature they were also being spaced apart in
2 the vertical and horizontal direction, and those would cause the form-fitting
3 elements to lock together in a vertical orientation.

4 Now, the other thing is that the Examiner had mentioned undercuts,
5 and that particularly the undercut could be this channel area, which I have
6 highlighted in figure number 5 as the channel here, highlighted in green,
7 which, again, is between the surfaces to the right of surface 22 and the other
8 full panel.

9 Now, that he refers to as the undercut, not the channel. The channel
10 was clearly not here. The undercut he refers to this. But what the Examiner
11 does when he says that this is the undercut, he says hey, you know what I
12 can do? I can turn this upside down, and now it's an undercut.

13 Well, that's fine and good, but now if you turn this upside down, what
14 ends up happening is you no longer have the other undercut that he mentions
15 here because now it would be an overcut. It's something that is now upside
16 down to the orientation that it was.

17 JUDGE McCARTHY: The undercut is recited only in claim 4?

18 MR. CALDERON: Claim number 4 we recite the undercut and claim
19 number 9. Dependent claim number 9 we also mention spaced-apart
20 undercuts which correspond to the form-fitting elements.

21 So in both of those we mention specifically the orientation -- the
22 relationship, excuse me, I should say, between the form-fitting elements and
23 the spaced-apart undercuts.

24 So clearly in figure number 5 -- and again I reference figure number 5,
25 but it certainly is the same in relation to number 6 and 7 of Palsson -- is that
26 take it one way or the other way; you are only going to have one undercut.

1 If you are going to turn it upside down, as the Examiner suggests to
2 do, then the original undercut which he suggested, which is near 23 and 24,
3 is no longer an undercut.

4 If you turn it back side up again -- right side up, excuse me, you have
5 one undercut which you should have for their locking mechanism at 23, 24,
6 but there's no undercut in this channel area over here.

7 In fact, if you read our claim in its entirety, what we are saying also is
8 that looking at the orientation of the channel to the right, for example, the
9 right panel would not be vertically locked due to that undercut at all.

10 It would be the other panel that may perhaps be locked due to that
11 undercut, if that's what you want to call it, but it's still not an undercut there.

12 Now, the last thing is -- if you don't have any particular questions
13 about that -- is this dust pocket. The dust pocket is something again that is
14 very unique in and of itself.

15 As you can imagine, we have these panels that require very tight
16 tolerances. If you don't have tight tolerances on the panel, what typically
17 will happen is that you will have some play. You'll get cracks between the
18 panels. Aesthetically it will not look nice. You get dust in there. And you
19 could have potentially a lot of different problems.

20 One of the problems, for example, is during the actual installation of
21 the panel itself.

22 When you install these panels, because they're of such tight
23 tolerances, if I had some dust in there, whether it be dirt, whether it be a
24 flake from the board itself, a remnant of the cut itself, what ends up
25 happening is that the form-fitting elements will not fit together. They will
26 not lock.

1 If you force them to lock, what ends up happening is there's the
2 potential of damaging the locking mechanisms or you will not be able to get
3 the floor flat so you won't have it in the plane.

4 The Examiner, however, says that this is inherent in Palsson. I would
5 say that this is not inherent in Palsson. Palsson clearly does not suggest any
6 problems with dust. Doesn't say any problems that there might be
7 concerning issues with the installation process during this.

8 The Examiner merely says that it's inherent. Well, that's not a basis
9 for inherency when there's nothing in there that says you have a particular
10 feature.

11 The Examiner then mentions the effect of tolerances, and the
12 Examiner specifically mentions that there can be certain tolerances, and
13 these tolerances themselves would be dust pockets.

14 Well, I would submit to the contrary that these tolerances -- first of
15 all, you have very high tolerances in these, and they're specifically
16 manufactured to have high tolerances because, as I mentioned before, we
17 want to make sure, we want to make sure that we have a tight fit between
18 these panels.

19 And if you have a tolerance between these to a certain extent, you are
20 not going to have that tight fit anymore. So you have to have the dust pocket
21 in a very particular area.

22 And the fact is that tolerances could come out in many different areas
23 anyway. It may come out in the tongue. It may come out in the groove. It
24 may come out in a certain area of the tongue and the groove that would not
25 even form a dust pocket.

26 So for example, if I take the portion of the tongue that is closest to

1 itself, its own panel or the side of the panel, and I have a tolerance that's over
2 there, that wouldn't cause the dust pocket itself.

3 You'll notice in figure number 1, for example, the dust pocket is really
4 formed in the inside portion of the groove itself.

5 JUDGE McCARTHY: Counsel, if there was a tolerance between the
6 tongue and the groove in which it fits, wouldn't the natural tendency of the
7 tiles to pull apart tend to distribute the openings caused by the tolerances to
8 the positions that are shown in figure 1?

9 MR. CALDERON: No, not necessarily, with all due respect. It really
10 depends on where you have the tolerances, where you have the particular
11 issue of your tolerances.

12 So it depends in that, for example -- I'll give you one example here.

13 It's really important to have very, very tight tolerances on the edge of
14 the panel and the top planar surface of the panel, because what this does over
15 here, as you can imagine, when the panels get pushed down, this being very
16 tight against one another actually pushes the panels away from each other
17 down here, while keeping it very tight over here, which could cause a dust
18 pocket over here.

19 But by the same token, if I have that same problem over here where
20 it's loose over here, that doesn't necessarily translate into a dust pocket over
21 here.

22 And I would go one step further in that I think it's two things. First, is
23 that looking at Palsson itself, looking at the figures, clearly Palsson does not
24 say that these are to scale.

25 Clearly, the view is, well, countless amount of case law says I can't
26 look at the figures themselves and look at them and say the figures show

1 something, when they're not specifically saying they're showing something;
2 they're not specifically saying they're to scale. Palsson is absolutely silent in
3 that.

4 That goes directly to an inherency issue where the Examiner says
5 look, the figures I just looked to. Well, yeah, you could look to the figures,
6 but if the figures don't show something, there's no suggestion in the actual
7 description itself that there's an issue or problem, there's no inherency in
8 there.

9 Going to the second aspect of the tolerances though, it's also well
10 settled and the CAFC actually has several cases with this, one being the
11 *Alloc* case, which was decided maybe about two years ago, about tolerances
12 and the importance of play compared to no play.

13 There was an infringement suit out there, and *Alloc* had play in the
14 particular panel. They specifically wanted play in the panel because it was
15 easier, they say, to be able to put the panels together.

16 The potential of the allegedly infringing device, though, did not have
17 this play. They specifically did not want the play in there. But there was
18 manufacturing tolerances.

19 The CAFC actually went on to say look, even if there are these
20 manufacturing tolerances in there, clearly they didn't intend to have play.
21 It's something that is incidental. They didn't want to have this.

22 And we all know that there's going to be some sort of tolerances or
23 manufacturing tolerances in there. But just because there's manufacturing
24 tolerances, in and of itself doesn't necessarily mean that you are designing it
25 and doing it the way that you are suggesting or the Examiner is suggesting in
26 Palsson.

1 Palsson doesn't say that we have any tolerances in there. Palsson
2 doesn't say that we have manufacturing issues that might arise. Palsson
3 doesn't mention anything about dust pockets.

4 Palsson doesn't mention anything about issues that are related to dust
5 being in here, such as, for example, I will not be able to lay the panels flat. I
6 will not be even able to lay the panels during installation. Nothing is
7 mentioned in there.

8 So taking that in combination with the *Alloc* decision and --

9 MR. McCARTHY: Do you have the cite for that case handy?

10 MR. CALDERON: Unfortunately, I do not have that cite.

11 MR. McCARTHY: Do you happen to remember the spelling?

12 MR. CALDERON: A-L-L-O-C, if I recall correctly, and that was
13 before the CAFC. That was about two years ago, if I recall. Maybe two and
14 a half years ago.

15 So clearly they mention that these are incidental things. But the fact
16 also is that with this particular reference, there's nothing in here that suggests
17 that there is going to be these tolerance difficulties in here. There's nothing
18 to suggest that the figures are to scale.

19 And so even though there are these tolerances that could be taken into
20 account -- and the *Alloc* decision specifically said that's not going to be a
21 matter of infringement -- I would say similarly such tolerance, even if you
22 took them into account, still doesn't show a dust pocket. They are still
23 theoretical. And the fact is that Palsson just doesn't show them at all.

24 So taking all that into combination, we think we have the dust
25 pockets, which are certainly unique, not shown in the Palsson reference.

26 We certainly have structural aspects which related to the form-fitting

1 elements that are both in the horizontal and vertical. Whereas, admittedly,
2 Palsson has a form-fitting element that stops or which locks in the vertical,
3 prevents vertical movement. I readily admit that.

4 That is something that's common. I could show you ten of those
5 particular references.

6 But having them spaced apart, due to the particular dimensions that
7 we are talking about, due to the manufacturing difficulties of manufacturing
8 a 10-millimeter panel and milling in these things certainly is not a trivial test
9 and certainly something that Palsson, nor any other reference I know about,
10 shows two form-fitting elements spaced apart in the vertical and the
11 horizontal.

12 JUDGE KERINS: Counsel, going to Claim 1 and the issue of the
13 form-fitting elements -- I probably should have asked this before -- do all the
14 form-fitting elements have to lock these panels in the vertical direction?
15 Can some be provided that do lock in a vertical direction and others that
16 don't, but yet they're still form-fitting elements?

17 MR. CALDERON: In this particular claim they are specifically
18 referred to as locking in the vertical position.

19 I've been doing these panel cases, and I'm very familiar, being to the
20 factory actually on a couple of occasions, seeing many of these floor panels,
21 and I was trying to see whether they would have a form-fitting element that
22 would stop it in the vertical, and I would say -- excuse me -- that would stop
23 it in the horizontal. And I would say yes, they are.

24 And in fact, it is shown right in Palsson itself, the form-fitting element
25 would be the entirety of the end of the groove itself. That little step over
26 there stops it in the horizontal.

1 So certainly there are mechanisms, and you need mechanisms that
2 stop it in the horizontal. But by the same token, you also need mechanisms
3 that stop it in the vertical. And there are mechanisms, single-sided
4 mechanisms that stop a vertical, but it doesn't stop a rotation. It doesn't stop
5 a full vertical of the vertical movement of the particular panel.

6 And again, that's one of the novel things is that by allowing us to have
7 two form-fitting elements, and again by having them both in the vertical and
8 the horizontal spaced apart, we are able to come to that advantage of
9 preventing that vertical rotation or the full vertical movement of the panels
10 because they are locked in the vertical.

11 So both claim number 1, both claim number 5.

12 And Your Honor McCarthy, to get back to your point, in the claims
13 itself we do mention that, in claim number 1 and claim number 5, that these
14 are formed on the walls, so we specifically mention form-fitting element on
15 walls.

16 So if you look at claim number 5, for example -- and let me get to
17 claim number 5 -- in claim number 1, for example, we specifically mention
18 that we have -- Form-fitting elements are spaced apart from one another in
19 the transverse direction and in the vertical direction on two spaced-apart,
20 essentially vertical-oriented walls 21 and 22.

21 We specifically mention in claim number 5 that we have -- The
22 second-sided edge includes a step -- excuse me -- a first step-like milled
23 relief, started from the underside and having an essentially vertical inner
24 wall, which is 21, and an essentially vertical outer wall, and the form-fitting
25 elements are formed respectively on the inner wall and the outer wall itself.

26 So we specifically mention that structure of it being in the walls or

1 formed on the walls itself in both claim 1 and 5.

2 JUDGE McCARTHY: What you are saying is if it is formed on the
3 wall, it can't be the wall.

4 MR. CALDERON: It is part of the wall. It is formed on it, yes.

5 JUDGE McCARTHY: But if it is formed on the wall, it can't also
6 meet the limitation of an essentially vertical-oriented wall?

7 MR. CALDERON: Well, it's part of formed on that wall. It would be
8 part of the wall itself. It is again that protrusion, as we mentioned, 23 and 24
9 that is in figure number 3 as well as figure number 2.

10 So I think we can liken this as far as a structure is concerned in the
11 claim, and I would personally be not interpreting this as a means plus
12 function claim under 112, sixth paragraph.

13 Now, I know that there's case law out there -- as a matter of fact, I
14 think the Board or the CAFC -- I can't recall offhand -- but just very recently
15 where they did mention that just because you don't use means for doing
16 something doesn't mean that it's not a means for a claim.

17 So if I said a -- I can't even think. They had some very specific
18 language that they used. Controller, for example, something that doesn't
19 connote structure in and of itself, could certainly be deemed a 112, sixth
20 paragraph.

21 With all due respect, I would say this does not fall within the auspices
22 of that recent case law and that this is in itself structure.

23 And not only does the form-fitting element itself connote a structure,
24 but in relation to all of the other elements in the claim taken in its entirety
25 would connote a structure, which clearly is different than the Palsson
26 reference in any of the figures, not even only figure 5, 6 and 7 which the

1 Examiner referred to, but all the figures themselves do not show that second
2 form-fitting element in order to prevent the panel to be lifted in the vertical,
3 ergo, in other words, not to lock it in the vertical.

4 We lock in the vertical by the two form-fitting elements.

5 JUDGE PATE: Thank you, Counsel.

6 MR. KERINS: I have no other questions.

7 JUDGE PATE: You overshot your time, anyway. I should watch that
8 more closely.

9 We are going to take this case under advisement. Thank you for your
10 time.

11 MR. CALDERON: Thank you very much.

12 (Whereupon, the proceedings at 2:35 p.m. were concluded.)